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| 09/457,049 | 12/07/1999 | SHMUEL SHAFFER | 99P7399US | 7243 |

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SIEMENS CORPORATION
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EXAMINER

NGUYEN, QUYNH H

| ART UNIT | PAPER NUMBER |
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2642

DATE MAILED: 09/10/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary

Application No.

09/457,049

Applicant(s)

SHAFFER ET AL.

Examiner

Quynh H Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed 6/30/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-33 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 1-3, 16, 21-23, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808).

Referring to claim 1, Wood teaches a method for enabling a caller ("a person at home who has accesses to web browser 12 and telephone 10") using a computer system comprising: providing a contact list (in "web facility 22", i.e. telephone number for Pizza place and see Abstract, lines 4-5) in which a called party can store a list of two or more contacts ("web facility 22 connected the call control system 32 that supports database 42" and see Abstract); and upon receiving a request the telephone connection message, referring to said contact list to automatically attempt to locate the called party (from the "web browser" to the "web facility" via network (web)) via a first contact method, the second contact method is via path 14 of Fig. 1, i.e. by telephone, fax, etc...; a response to the telephone connection message from the network (web) to a web browser and attempt to reach the called party (col. 2, lines 13-16) by clicking the DIAL button (col. 6, lines 42-55).

Wood does not teach a method to locate the called party but rather the method of making a telephone connection facilitating the computer network facility to a telephone switch via a switch computer interface, in response to which the switch sets up the

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desired telephone connection to the called party in the same manner as if the called party number had been dialed by the subscriber at the telephone.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method for providing telephone call control and information as described in Wood for locating the called party in order to have a complete and sufficient system.

Referring to claims 2 and 3, Wood teaches contact list manager comprises: one or more contact methods for each contact; and one or more rules applicable to contacts and contact methods regarding when or how to send a locator request one or more contact methods is one or more methods selected from the group consisting of one or more telephone numbers (col. 9, lines 46-57).

Claim 16 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Wood teaches the first destination is the "network (web)" and the second destination is the "telephone switch 16 (central office, PSTN, or a PBX...)" reads on claimed "the first and second destinations are of different multimedia types"; and Wood teaches when a caller access the web browser would send out a location request to database 42 in the call control system 32 that connected to the web facility 22 to locate the called party.

Referring to claim 21, Wood teach the telephone number information can comprise a personal telephone directory of the subscriber (col. 2, lines 24-25); and the caller would have the option to pick up the phone 10 and dial the full telephone number to reach the called party or click a dial button that triggers the telephone switch to set up

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a telephone connection between the subscriber's telephone 10 and the called party.

However, Wood does teach the second contact method includes a telephone number is entered in full by a responding party. It would have been obvious to one of ordinary skill in the art to incorporate the feature of entering in full a telephone number by a responding party in Wood's system in order to have a more diversity and better system.

Referring to claim 22, Wood teaches the first contact method is via network (web). Obviously, an e-mail address is part of accessing the Internet or network (web).

Referring to claim 23, Wood teaches automatically extracting the second contact method from the response (col. 2, lines 13-16).

Referring to claim 26, Wood does not teach recording and playing the response for the caller. Since Wood's system would allow subscriber to click a DIAL button to automatically connect to the called party or one may choose to pick up the phone and dial the number. Therefore, there is no need to record the second contact method and playing the response for the caller.

Referring to claim 27, Wood teaches using first contact method via network (web) and second contact method via "telephone switch" to make a telephone connection between the calling and called party reads on claimed "concurrently sending messages to each of at least two contacts of the two or more contacts in response to a single request to locate a called party".

3. Claims 4, 17-20, 28, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808) in view of Brennan et al. (U.S. Patent 5,329,578).

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Referring to claim 4, Wood does not teach contact list database stores additional contact information designating the conditions for usage of the contacts or the contact methods.

Brennan teaches contact list database stores additional contact information designating the conditions for usage (Table 4.0 and col. 7, lines 47-60) of the contacts or the contact methods.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a list of contact information designating the conditions for usage in order to provide special treatment for urgency calls.

Referring to claim 17, Brennan teaches one or more contact lists (Table 5.0) associated with one or more called parties; and one or more rule sets (col. 7, lines 47-50) associated with one or more called parties.

Referring to claim 18, Brennan teaches one or more system or group contact lists (Table 2.0, other devices) providing contacts that are applicable to more than one called party; and one or more system or group rule sets (Table 4.0, entries under Day & Time) applicable to more than one called party.

Referring to claim 19, Brennan teaches an interface for receiving one or more responses (col. 10, lines 34-43) to location requests; and a presentation module (col. 13, line 68 through col. 14, line 3) for presenting responses to a caller.

Claim 20 is rejected for the same reasons as discussed above with respect to claim 6.

Claim 28 is rejected for the same reasons as discussed with respect to claim 6.

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Referring to claim 33, Wood teaches communicating the telephone connection message using the web browser reads on claimed "the first and second contact methods is an address for text-based messaging".

4. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808) in view of Cheston, III et al. (U.S. Patent 6,330,308).

Referring to claim 24, Wood does not teach the first contact method is a telephone number, the second contact method is a telephone number spoken verbally by a responding party via telephone, and said automatically extracting said second contact method from the response includes using speech recognition software to extract the second contact method.

Cheston, III teaches an automated directory assistance system to obtain called party telephone number from directory assistance system using speech recognition capabilities. The directory service system retrieves the number for the destination (col. 7, lines 20-33) reads on claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine voice recognition system for automatically extracting the second contact method into the system to locate the called party to provide a diversity system with a wide variety of options for locating the called party.

5. Claims 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808) in view of Herbst (U.S. Patent 4,941,170).

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Referring to claim 25, Wood does not teach the automatically processing the response comprises automatically extracting the second contact method using optical recognition software.

Herbst teaches a facsimile transmissions system that decodes a mark sense cover sheet facsimile data to be accessed by numerous conventional facsimile machines with no specialize adaptations to the facsimile machines. Also no modifications need to be made to the electronic mail system; the facsimile controller is programmed to provide it with the sender identity a destination address as needed by the electronic mail system reads on claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that one possible way to automatically extracting the second contact method is using optical recognition software.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808) in view of Brennan et al. (U.S. Patent 5,329,578) and further in view of Kugell et al. (U.S. Patent 5,802,160).

Referring to claim 5, Brennan et al. teaches automatic attempting to locate said called party comprises: automatically sending one or more messages (Table 4.0, treatment and col. 7, lines 58-60) to parties listed in a contact list requesting location information (Table 4.0, day, time, treatment) regarding said called party, receiving responses to said one or more messages and presenting a response to a calling party (col.13, line 63 through col. 14, line 5).

Wood and Brennan do not teach canceling outstanding messages when a response is received.

Kugell teaches a method and system for providing telephone service wherein a plurality of telephone numbers are simultaneously signaled to allow a calling party to find a called party and after the signaling at least one of the plurality numbers is terminated, others would stop ringing read on claimed "canceling outstanding messages when a response is received".

It would have been obvious to one of ordinary skill in the art at the time the invention was made to cancel outstanding contact messages once the party of interest has been located to save the system's resources allocation.

7. Claims 6, 9-15, 29-32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kugell et al. (U.S. Patent 5,802,160) in view of Brennan et al. (U.S. Patent 5,329,578).

Claim 6 is rejected for the same reasons as discussed above with respect to claim 5. Furthermore, Kugell does not teach the method for locating a called party.

Brennan teaches the method for locating a called party.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method for locating the called party as described in Kugell system in order to have a complete and sufficient system.

Referring to claim 9, Brennan teaches a called party is identified and identities of called parties (Table 4.0, Day and Time) are used in part to determine system behavior (Table 4.0, Treatment and Urgency).

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Referring to claim 10, Brennan teaches called party may configure system behavior for a calling party (col. 4, line 67 through col. 5, line 2 and Table 1.0).

Referring to claim 11, Brennan teaches messages are predetermined prior to receiving said request (col. 10, lines 37-48).

Referring to claim 12, Brennan teaches the prompt play back unit and these prompts are usually the ones provide by the service provider with information regarding the called party (col. 10, lines 34-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made that the parties on the contact list may also submit responses to the messages with information regarding the called party.

Referring to claim 13, Brennan teaches the calling party is automatically notified of said responses (col. 10, lines 34-37), responses contain a contact method for reaching the called party (col. 6, lines 42-45), the last limitation is rejected for the same reasons as claim 6.

Referring to claims 14 and 15 are rejected for the same reasons as discussed above with respect to claim 13.

Claim 29 is rejected for the same reasons as discussed above with respect to claim 16 and Brennan teaches the address is verbally entered by a responding party to indicate the location of the called party (col. 10, lines 34-43).

Claims 30 and 35 are rejected for the same reasons as discussed above with respect to claim 33.

Claim 31 is rejected for the same reasons as discussed above with respect to claims 24 and 25.

Claim 32 is rejected for the same reasons as discussed above with respect to claim 23.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kugell et al. (U.S. Patent 5,802,160) in view of Brennan et al. (U.S. Patent 5,329,578) and further in view of Will (U.S. Patent 5,905,789).

Referring to claim 7, Kugell and Brennan do not teach allowing a called party to configure contact list.

Will teaches called party can configure contact list (col. 4, lines 54-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to let user create/configure contact list in order to suit his/her needs.

Response to Arguments

9. Applicant's arguments filed 6/30/03 have been fully considered but they are not persuasive. Applicant's arguments are addressed in the above claims rejection.

Applicant argues that Wood's remote dialer machine assumes and requires that the phone number is already known by the caller. Examiner respectfully disagrees. Wood teach database 42 comprises a commercially available database manager using SQL (structured query language) to perform query functions such as: names, telephone numbers and e-mail ID, for example, caller would like to order Pizza without knowing a telephone number of the Pizza place will send a message to the web facility via a first contact method (path 18 of Fig. 1); and upon receiving a request to locate the Pizza place from the web browser to the web facility via network ("web") and automatically

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processing the response to facilitate the use of the second contact method to attempt to reach the Pizza place by clicking the DIAL button. Since it's not clear as to what "...a person other than a called party..." is, examiner assumes that the person is the caller at home who has access to web browser 12 and telephone 10.

Applicant argues that Wood does not teach sending of the messages to multiple parties is in response to the single request to locate the called party. Examiner respectfully disagrees. Wood teaches in response to the single request to locate the called party (**not to dial**), for example, the Pizza place. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

10. This is a Request for Continued Examination (RCE) of applicant's earlier Application No. 09/457049. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 703-305-5451. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

qhn

Quynh H. Nguyen
September 4, 2003


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